

12/20/99  
jc672 U.S. PTO

Patent  
Attorney's Docket No. 012712-813

A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR FILING CONTINUATION/DIVISIONAL  
APPLICATION UNDER 37 C.F.R. § 1.53(b)

Box PATENT APPLICATION  
Assistant Commissioner for Patents  
Washington, D.C. 20231

jc564 U.S. PTO  
09/467317  
12/20/99

Sir:

This is a request for filing a ☒ continuation ☐ divisional application under 37 C.F.R. § 1.53(b) of pending Application No. 08/742,480 filed on November 1, 1996, for CD40CR RECEPTOR AND LIGANDS THEREFOR, by the following named inventor(s):

- (a) Full Name Randolph J. NOELLE  
(b) Full Name \_\_\_\_\_  
(c) Full Name \_\_\_\_\_

☒ The entire disclosure of the prior application from which a copy of the oath or declaration is supplied herewith is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

☒ This application is being filed by less than all the inventors named in the prior application. In accordance with 37 C.F.R. 1.63(d)(2), the Commissioner is requested to delete the name(s) of the following person or persons who are not inventors of the invention being claimed in this application.

- (a) Full Name Alejandro ARUFFO  
(b) Full Name Jeffrey LEDBETTER  
(c) Full Name Ivan STAMENKOVIC

☐ This application is being filed by more than all the inventors named in the prior application. In accordance with 37 C.F.R. 1.63(d)(2), the Commissioner is requested to add the name(s) of the following person or persons who are inventors of the invention being claimed in this application.

- (a) Full Name \_\_\_\_\_



21839

(b) Full Name \_\_\_\_\_  
(c) Full Name \_\_\_\_\_

1. ☒ Enclosed is a copy of the prior Application No. 07/835,799 as originally filed on February 14, 1992, now abandoned, including copies of the specification, claims, drawings and the executed oath or declaration as filed.
2. ☐ Enclosed is a revised prior application and a copy of the prior executed oath or declaration as filed. No new matter has been added to the revised application.
3. ☐ \_\_\_\_\_ statement(s) claiming small entity status ☐ are enclosed ☐ were filed in prior Application No. \_\_, filed on \_\_.
4. ☒ The filing fee is calculated below ☒ and in accordance with the enclosed preliminary amendment:

CLAIMS					
	NO. OF CLAIMS		EXTRA CLAIMS	RATE	FEE
Basic Application Fee					\$760.00 (101)
Total Claims	72	MINUS 20 =	52	x \$18.00 (103) =	\$936.00
Independent Claims	12	MINUS 3 =	9	x \$78.00 (102) =	\$702.00
If multiple dependent claims are presented, add \$260.00 (104)					\$260.00
Total Application Fee					\$2,658.00
If small entity status is claimed, subtract 50% of Total Application Fee					
Add Assignment Recording Fee of if Assignment document is enclosed					
<b>TOTAL APPLICATION FEE DUE</b>					<b>\$2,658.00</b>

5. ☐ Charge \$ \_\_\_\_\_ to Deposit Account No. 02-4800 for the fee due.
6. ☒ A check in the amount of \$ 2,658.00 is enclosed for the fee due.

7. ☒ The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in triplicate.

8. ☒ Cancel in this application original claims 1-41 of the prior application before calculating the filing fee.

9. ☒ Amend the specification by inserting before the first line the sentence: This application is a [X] continuation, [ ] divisional, of Application No. 08/742,480, filed November 1, 1996, in turn a continuation of Application No. 08/338,975, filed November 14, 1994, in turn a continuation of Application No. 07/835,799, filed February 14, 1992, now abandoned.--

10. ☐ Transfer the drawings from the pending prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate of this paper is enclosed for filing in the prior application file. (May only be used if signed by person authorized under 37 C.F.R. § 1.138 and before payment of issue fee.)

11. ☒ New drawings are enclosed.

12. ☐ Priority of Application No. \_\_ filed on \_\_ in \_\_ (country) is claimed under 35 U.S.C. § 119.

☐ The certified copy of the priority application

☐ is enclosed

☐ was filed on \_\_ in prior Application No. \_\_, filed on \_\_

☐ has not yet been filed.

13. ☒ A preliminary amendment is enclosed.

14. ☐ A General Authorization for Payment of Fees and Petitions for Extensions of Time.

15. ☒ Also enclosed is a copy of the Order in Interference No. 104,415 and a copy of U.S. Patent No. 5,993,816.

16. ☒ The power of attorney in the prior application is to E. Joseph Gess, Burns, Doane, Swecker & Mathis, L.L.P.

a. ☒ The power appears in the original papers in the prior application.

b. ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c. ☐ Recognize as Associate Attorney \_\_.

- d. ☒ Address all future communications to: (May only be completed by applicant, or attorney or agent of record.)

E. Joseph Gess  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404

December 20, 1999  
Date

By: Robin L. Teskin  
Robin L. Teskin  
Registration No. 35,030

ADDRESS OF  
SIGNATOR:

BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

☐ inventor(s)  
☐ assignee of complete interest  
☐ attorney or agent of record  
☒ filed under 37 C.F.R. § 1.34(a)

THIS PAPER IS NOT BINDING PRECEDENT OF THE BOARD

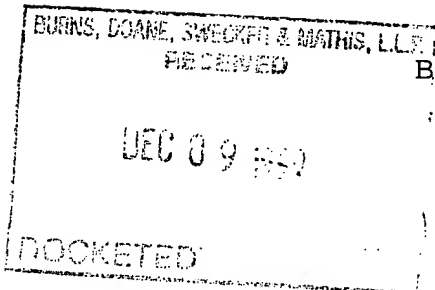
Filed by:

Richard Torczon  
Administrative Patent Judge  
Box Interference  
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Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

JC564 U.S. PTO  
09/467317  
12/20/99



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

RANDOLPH NOELLE  
(08/742,480),

Junior Party,

MAILED

DEC 7 - 1999

v.

SETH LEDERMAN, LEONARD CHESS,  
and MICHAEL J. YELLIN  
(5,474,771),

Senior Party.

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Patent Interference No. 104,415

ORDER

(SETTING TIMES FOR PRELIMINARY MOTIONS  
AND PRELIMINARY STATEMENTS)

**A. Conference call**

A telephone conference call was held on 7 December 1999, at approximately 2 p.m., involving:

1. Danny Huntington, Robin Teskin, Ken Woolcott, and Chris Dayton for Noelle;
2. James Haley, Margaret Pierri, Jane Gunnison, Louis Weinstein, Stanley Liang, John White, and Jane Love for Lederman; and
3. Richard Torczon, Administrative Patent Judge.

**B. Relevant discussion during conference call**

The principal purpose of the conference call was to set times for taking action during the preliminary motion phase of the interference. The times set are those proposed by counsel except for the last two dates, which were extended by the administrative patent judge.

During the call it became apparent that Noelle must update its Rule 602 statement. The parties should promptly update their Rule 602 statements whenever changes in interest occur.

Noelle will file a continuing application to preserve its options under 35 U.S.C. § 135(b) with respect to Lederman's 5,993,816 patent. Noelle will file and serve a notice in the present interference identifying the application as soon as it receives a serial number. Both parties should continue to identify related proceedings that might affect or be affected by this proceeding as they arise.

By the end of the preliminary motions period set here, both parties may have applications or patents that are sufficiently related to warrant inclusion in this interference as separate counts. Alternatively, they may warrant additional interferences with concurrent priority phases. Consequently, after this preliminary motions phase concludes, the parties should schedule a conference call with the administrative patent judge to discuss whether a truncated motions period to add counts would be appropriate. During the truncated motions period, motions

alleging unpatentability would only be permitted by leave of the designated administrative patent judge.

Lederman's proposed motion 8 to request an order under 37 CFR § 1.641 is too speculative to be appropriate. Mr. Haley indicated that the motion would not be filed. Nothing in this discussion would bar Lederman from filing a related motion if facts are developed that would support such a motion.

**C. Time periods associated with preliminary motions**

In accordance with discussion during the telephone conference call, the following "TIME PERIODS", as set out in an Appendix to this ORDER, are established in this interference:

**1. TIME PERIOD 1**

The time for filing and serving preliminary motions (37 CFR § 1.636(a)) is set to expire at the end of TIME PERIOD 1.

If no party files a preliminary motion, the parties should place a conference call to the administrative patent judge so that a time for taking testimony or other appropriate action may be set.

Attention is directed to ¶ 26(f) of the NOTICE DECLARING INTERFERENCE (Paper No. 1) if a request is made for leave to take testimony to support a preliminary motion.

Attention is directed to ¶ 26(g) of the NOTICE DECLARING INTERFERENCE (Paper No. 1) with respect to any preliminary motion for judgment (37 CFR § 1.633(a)) based on inequitable conduct or fraud.

**2. TIME PERIOD 2**

The time for filing and serving preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)) is set to expire at the end of TIME PERIOD 2.

**3. TIME PERIOD 3**

The time for filing and serving oppositions to all preliminary motions, including preliminary motions filed pursuant to 37 CFR § 1.633(i) and (j), is set to expire at the end of TIME PERIOD 3.

**4. TIME PERIOD 4**

The time for filing replies to all oppositions is set to expire at the end of TIME PERIOD 4.

**5. TIME PERIOD 5**

The time for filing:

- a. if a party desires a hearing on preliminary motions, a request for a hearing;
- b. motions to suppress evidence relied upon by an opponent in connection with preliminary motions (compare 37 CFR § 1.656(h)); and
- c. observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 5.



**6. TIME PERIOD 6**

The time for filing:

- a. oppositions to an opponent's motion to suppress and
- b. a response to observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 6.

**7. TIME PERIOD 7**

The time for filing replies to oppositions to motions to suppress is set to expire at the end of TIME PERIOD 7.

The parties are authorized to stipulate different times (earlier or later, but not later than TIME PERIOD 7) for TIME PERIODS 1 through 6, provided a notice is filed with the board as soon as practical after any agreement is reached. The notice should be in the form of a photostatic copy of the Appendix attached to this ORDER with old dates crossed out and new dates inserted by hand.<sup>1</sup> The parties may not stipulate an extension beyond presently set TIME PERIOD 7.

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<sup>1</sup> The purpose of this requirement is to make it easy for personnel at the board to determine the changes in dates agreed to by the parties.

**D. Deposition transcripts**

Transcripts of depositions of cross-examination or depositions taken under 35 U.S.C. § 24 shall be served, but not filed with the Board until the exhibits are filed.

**E. Serving exhibits relied upon in preliminary motions**

An exhibit, including an affidavit, relied upon in connection with preliminary motions, oppositions, and replies shall be served (but not filed) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned.

**F. Time for filing the record in connection with preliminary motions**

**TIME PERIOD 8**

On or before the expiration of TIME PERIOD 8,

1. An original and three copies of each exhibit, including affidavits, and deposition transcript should be filed with the board. Exhibits should be filed in an accordion folder, box, or other folder containing all exhibits in numerical order (the copies of exhibits should be submitted in like fashion in an accordion type or other folders).
2. Three copies of preliminary motions, oppositions, and replies previously filed should be filed with the board; with each copy of each motion, its opposition, its reply, and any observations and

any response to observations being filed in a separate folder.

3. Any ZIP® disk or CD-ROM that a party elects to file.

**G. Preliminary statements**

The time for filing (but not serving) preliminary statements (37 CFR § 1.621(a), see also 37 CFR § 1.627(a)) is the same as the time for complying with **TIME PERIOD 1**.

The time for filing the notice required by 37 CFR § 1.621(b) is the same as the time for complying with **TIME PERIOD 1**.

A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party. 37 CFR § 1.631(b). Without further order of the board, **within one (1) week after** the date for filing preliminary statements, a copy of a party's preliminary statement shall be served on each opponent who served a notice under 37 CFR § 1.621(b).

  
RICHARD TORCZON  
Administrative Patent Judge

Interference No. 104,415  
Noelle v. Lederman

Paper No. 23  
Page 8

cc (via first-class mail):

Counsel for Noelle  
(real party in interest, Trustees of Dartmouth College):

R. Danny Huntington  
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Counsel for Lederman  
(real party in interest, Trustees of Columbia University;  
licensees-Biogen, Inc. and the United States of America (NIH)):

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Margaret A. Pierri  
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Fax: 212-391-0525

**APPENDIX**  
**(to the ORDER - FILING OF PRELIMINARY MOTIONS AND STATEMENTS)**

- |    |  |                   |
|----|--|-------------------|
| 1. | TIME PERIOD 1<br>Filing preliminary motions  | 7 April 2000      |
| 2. | TIME PERIOD 2<br>Filing Rule 633(i) and<br>Rule 633(j) preliminary motions   | 21 April 2000     |
| 3. | TIME PERIOD 3<br>Filing of oppositions to all preliminary<br>motions   | 7 June 2000       |
| 4. | TIME PERIOD 4<br>Filing of replies   | 7 August 2000     |
| 5. | TIME PERIOD 5<br>Filing of request for hearing; motions to<br>suppress and observations with respect to<br>cross-examination           | 7 September 2000  |
| 6. | TIME PERIOD 6<br>Filing of oppositions to motions to<br>suppress and any response to observations<br>with respect to cross-examination | 21 September 2000 |
| 7. | TIME PERIOD 7<br>Filing replies to oppositions to motions<br>to suppress   | 31 October 2000   |
| 8. | TIME PERIOD 8<br>Filing the record   | 7 November 2000   |